

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM A. WEST

Appeal No. 1999-1785
Application 08/512,656

ON BRIEF

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent
Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal
to allow claims 11, 12, 15 and 17 through 20 as amended
subsequent to the final rejection in a paper filed October 14,

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1997 (Paper No. 10). Claims 21 through 34 are withdrawn from consideration as drawn to non-elected inventions. Claims 1 through 9 and 16 are allowed. Claims 10, 13 and 14 have been canceled.

BACKGROUND

The appellant's invention relates to an improved bearing assembly. An understanding of the invention can be derived from a reading of exemplary claim 11, which appears as follows:

11. An improved bearing comprising:

(1) an internal member;

(2) an external member disposed upon said internal member, said external member and said internal member forming a seat for at least one seal member between said external member and said internal member for sealing between said external member and said internal member, at least a portion of one of said members extending beyond at least a portion of the other of said members thereby forming said seat.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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Bechman 1944	2,349,898	May 30,
Totten 1990	4,979,722	Dec. 25,

Claims 11, 12, 15, 18 and 19 stand rejected under 35
U.S.C. § 102(b) as being clearly anticipated by Totten.

Claims 11, 12, 15, 18 and 20 stand rejected under 35
U.S.C. 102(b) as being clearly anticipated by Bechman.¹

Claim 17 stands rejected under 35 U.S.C. § 103(a) as
being unpatentable over Totten.

Rather than reiterate the conflicting viewpoints advanced
by the examiner and the appellant regarding the above-noted
rejections, we make reference to the examiner's answer (Paper
No. 16, mailed June 25, 1998) for the examiner's complete
reasoning in support of the rejections, and to the appellant's

¹ Claim 13 also stands rejected under 35 U.S.C. § 102(b)
as being clearly anticipated by Bechman, however, we note that
claim 13 has been canceled by appellant in an amendment
subsequent to the final rejection (Paper No. 10, filed October
14, 1997).

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brief (Paper No. 15, filed June 2, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner.² As a consequence of our review, we make the determinations which follow.

Initially, we observe that the brief contains arguments

² Our review of the application file reveals that the specification, claims and drawings are replete with errors, too numerous to list in total. Examples of such errors are: (1) Claim 1 contains improper capital letters in lines 3, 4 and 6, (2) on page 5, line 10 --with-- is misspelled, (3) the description of Figures 6 and 6A found on page 7 of the specification refers to reference numerals 46 and 57, however, these reference numerals are not shown on the appropriate drawing figures, (4) reference numerals 49 and 49A shown at the top of Figure 6 appear to be inappropriately placed, (5) Figure 5C has reference numerals that do not match those found in the description of the figure at the bottom of page 8 in the specification, etc. These issues should be addressed by the examiner and the appellant upon further prosecution of the application.

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concerning the propriety of the examiner's final rejection. In that regard, appellant argues that the finality of the rejection was premature, and that the examiner failed to sufficiently explain the pertinency of the cited references to the claims on appeal. We must point out, however, that under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general supervisory power over the examining corps, and decisions of primary examiners to issue final rejections and the completeness of those rejections are not subject to our review. See MPEP §§ 706.07(c), 1002.02© and 1201 (7th ed., Jul. 1998). Thus, the relief sought by the appellant would have properly been presented by a petition to the Commissioner under 37 CFR § 1.181. Accordingly, we will not further comment on or consider this issue.

The examiner states (answer, page 2) that "[t]he rejection of claims 11, 12, 15 and 18-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall

together and reasons in support thereof." However, we observe that appellant has separately argued the patentability of dependent claims 12, 15 and 18 through 20 apart from independent claim 11 with a reasonable degree of specificity (brief, pages 6-9). As a result of the foregoing, we will treat claims 12, 15 and 18 through 20 separately, and not in the manner stated by the examiner as standing or falling on the limitations of claim 11.

We turn first to the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) as being clearly anticipated by Totten. Totten discloses (e.g., in Fig. 3) a butterfly actuator having a bearing assembly comprising an internal member 88, and an external member 92 disposed upon the internal member. The external member 92 and the internal member 88 form a seat for at least one seal member 104 between the external member and the internal member for sealing between the external member and the internal member. At least a portion of one of the members extends beyond at least a portion of the other of the members thereby forming the seat. The appellant argues that "the claimed invention does not

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contain a groove for a seal as required by the Totten reference and Totten accordingly does not anticipate applicant's invention claimed in twice-amended Claim 11" (brief, page 6). We do not agree. A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)). Appellant's claim 11 on appeal merely requires that the external member and the internal member form a "seat" for the at least one seal member. We observe that appellant's groove 59 in external member 52" (Figure 6C) defines, at least in part, a recess or "seat" for seal member 54. Similarly, Totten shows grooves 166, 168 which at least in part define

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the recess or "seat" which receives seals 104. Therefore, because Totten shows a "seat" as broadly claimed and discloses each and every element of claim 11, we will thus sustain the examiner's rejection of this claim under 35 U.S.C. § 102(b).

In looking at the examiner's rejection of Claim 12 on appeal under 35 U.S.C. § 102(b) as being clearly anticipated by Totten, we see that dependent claim 12 expressly requires that the external member define at least one groove for receiving the seal member. The appellant's argument that "[n]o such groove between an external member and an internal member appears in Totten" (brief, page 7) is not understood and would seem to be directly in conflict with appellant's argument (brief, page 6) regarding Totten and its use against independent claim 11 on appeal. As we stated above, Totten clearly shows grooves 166, 168 in external member 92 for receiving seal member 104. Thus, we will sustain the examiner's rejection of claim 12 under 35 U.S.C. § 102(b) as being clearly anticipated by Totten.

We turn to the rejection based on Totten under 35 U.S.C.

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§ 102(b) of claims 15 and 18. We see that claims 15 and 18 require that a seal member be disposed in the seat, and that the internal member and external members be "fitted together", respectively. Appellant's argument (brief, page 7), with respect to each of these claims, is simply that no such element appears in, or is disclosed in Totten. Again, it is quite clear to us that Totten does indeed show a seal 104 disposed in a seat defined between the internal and external members, and the internal member 88 being "fitted together" with external member 92 in the assembled actuator depicted in Figure 3 of the patent. We will, therefore, sustain the examiner's rejection of claims 15 and 18 under 35 U.S.C. § 102(b) as being clearly anticipated by Totten.

Looking at the rejection of claim 19 under 35 U.S.C. § 102(b) as being clearly anticipated by Totten, we see that claim 19 recites that the "internal member defines an internal bore." The patent to Totten shows an internal member 88 that appears to be solid, and thus includes no such internal bore. Accordingly, we must agree with appellant that "an internal bore in the internal member does not appear in Totten"

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(brief, page 7). Since each and every element of appellant's claim 19 is not shown, either explicitly or inherently in Totten, the examiner's rejection of claim 19 under 35 U.S.C. § 102(b) based on Totten will not be sustained.

We turn now to the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) as being clearly anticipated by Bechman. We find that Bechman discloses (Figure 2) a track roller having a lubricated bearing assembly with an internal member 18, and an external member 19 disposed upon the internal member 18. The external member and the internal member form a seat for at least one seal member 25 between the external member and the internal member, for sealing between the external member 19 and the internal member 18. At least a portion of one of the members extends beyond at least a portion of the other of the members thereby forming the seat. We are unpersuaded by appellant's arguments (brief, page 8) regarding Bechman. These arguments are not well taken, as they are directed to the lubrication fitting shown in Figure 4 of Bechman, and do not address the disclosed features of the bearing assembly noted above. Since Bechman discloses each

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and every feature of claim 11, we will thus sustain the examiner's rejection of claim 11 under 35 U.S.C. § 102(b) under Bechman.

We next consider the examiner's rejection of claims 12, 15, and 18 under 35 U.S.C. § 102(b) as being clearly anticipated by Bechman. In that regard, we observe that Bechman additionally discloses external member 19 defining at least one groove for receiving the seal member 25 (appellant's claim 12), a seal member 25 disposed in the seat (appellant's claim 15), and an internal member 18 and external member 19 fitted together (appellant's claim 18). Appellant's arguments again do not properly address the issues at hand. Appellant's arguments are primarily directed to the lubrication fitting of Figure 4, rather than the bearing assembly itself (Bechman, Figure 2). As before, since each and every feature of appellant's claims 12, 15 and 18 are disclosed in Bechman we will, therefore, sustain the examiner's rejection of theses claims under 35 U.S.C. § 102(b).

We next review the examiner's rejection of claim 20 under

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35 U.S.C. § 102(b) as being clearly anticipated by Bechman. We note that claim 20 requires that the "internal member is substantially solid." This claim appears to be directed to the embodiment of appellant's invention seen in Figure 7 of the application, where the internal member 32" is shown to be a solid shaft. In looking at the bearing assembly of Bechman, we see an internal member 18 having an internal pocket or chamber 21. It appears to us that the internal member of Bechman is not "substantially solid", as required by appellant's claim 20 on appeal. We must agree with appellant that a "substantially solid" internal member does not appear in Bechman (brief, page 8). Since each and every feature of appellant's claim 20 is not explicitly or inherently shown in Bechman, we will, therefore, not sustain the examiner's rejection of claim 20 under 35 U.S.C. § 102(b).

We next review the examiner's rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Totten. Claim 17 recites that:

said seal member includes a seal body and a seal lip
and wherein said seal body seats against said

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internal member and said seal lip contacts said
external member.

The examiner determined that the bearing assembly of Totten lacks a seal body seating against an internal member and a seal lip contacting an external member and concluded that:

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have the lip portion contact the external member and the body portion on the internal member as this would have been an obvious variant to one of ordinary skill in the art.

We do not agree. Essentially, it is the examiner's position that one of ordinary skill in the art would have found it prima facie obvious to modify the Totten device without evidence or prior art in support thereof. In the absence of evidence or compelling argument in support thereof, however, we are not persuaded that this would have been the case.³ In our view, the only suggestion for modifying Totten in the

³ The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir.1984).

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manner proposed by the examiner to meet the above-noted limitations of appellant's claim 17 stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Totten.

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection against appellant's claims 1, 2, 3, 4, 6, 16, 19 and 20.⁴

Claims 1, 2, 6 and 20 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Totten. Having previously discussed Totten, we further note that Totten

⁴ In October, 1997, 37 CFR 1.196(b) was amended to permit this Board to enter a new ground of rejection against "any pending claim", including any claim previously allowed by the examiner or indicated by the examiner to contain allowable subject matter.

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discloses a unitary butterfly actuator assembly 80, a journal member 98 "disposed" upon substantially solid internal member 88, and an external member 92 "disposed" upon the journal member 98. As noted before, external member 92 includes grooves 166, 168 that in part define a seat between the internal and external members for receiving seal member 104. In view of the foregoing, it is our opinion that Totten shows each and every element of the invention recited in appellant's claims 1, 2, 6 and 20.

Claims 1, 3, 4, 6 and 19 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Bechman. Having previously discussed Bechman, we further observe that Bechman discloses a unitary assembly having a generally hollow internal member 18 having channels and an internal bore or chamber 21, a journal member 24 "disposed" on the internal member, and an external member 19 "disposed" upon the journal member 24. As noted supra, in our discussion of the examiner's rejections of claims 11 and 12, the external member 19 of Bechman defines a groove for receiving seal member 25. In view of the foregoing, it is our opinion that Bechman shows

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each and every feature of the invention recited in appellant's claims 1, 3, 4, 6 and 19.

Claim 16 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008,

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1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

With this as background, we conclude that there is no evidence of record that appellant had possession of the subject matter recited in claim 16 at the time of filing the application. In particular, we can find no description in the specification or showing in the drawings that would convey to one of ordinary skill in this art that appellant was, as of the filing date of the application, in possession of a seat for a seal member wherein at least a portion of the seat is beveled, and wherein the seal lip contacts the internal member

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at the beveled portion. In that regard, we do not consider that one of ordinary skill in the art would have viewed the arcuate cutout in the internal member 31' seen in Figure 5C of the application as providing a seat with a beveled portion.

CONCLUSION

To summarize, the decision of the examiner to reject claims 19 and 20 under 35 U.S.C. § 102(b) is reversed, the decision of the examiner to reject claim 17 under 35 U.S.C. § 103(a) is reversed and the decision of the examiner to reject claims 11, 12, 15 and 18 under 35 U.S.C. § 102(b) is affirmed. New rejections of claims 1, 2, 3, 4, 6, 19 and 20 under 35 U.S.C.

§ 102(b) have been added pursuant to the provisions of 37 CFR § 1.196(b), and a new rejection of claim 16 under 35 U.S.C. § 112, first paragraph, has also been added pursuant to the provisions of 37 CFR § 1.196(b).

We AFFIRM-IN-PART and enter new grounds of rejection pursuant to 37 CFR 1.196(b).

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In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53, 131, 53, 197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "new grounds of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the

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application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejections, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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